REMARKS

Claims 1-5, 7, 9-14, 16, 18-21, 52, and 53 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). Claims 6, 8, 15, and 17 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Bartholomew in view of Stumer or Yoon. As will be shown below, Bartholomew, Stumer, or Yoon, alone or in combination, do not teach each and every element of claims 1-21, 52, and 53. Claims 1-21, 52, and 53 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-21, 52, and 53.

Election/Restriction

The Office Action of April 23, 2003 identifies two groups within the 53 claims filed in the present application. Group I includes claims 1-21, 52, and 53. Group II includes claims 22-51. In a telephonic interview on April 2, 2003, Applicants provisionally elected with traverse Group I including claims 1-21, 52, and 53 for prosecution in the present case. Applicants affirm the provisional election with traverse of Group I including claims 1-21, 52, and 53. Please cancel claims 22-51.

Claim Rejections – 35 U.S.C. §102

Claims 1-5, 7, 9-14, 16, 18-21, 52, and 53 stand rejected under 35 U.S.C 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."[1] Because Bartholomew does not teach each and every element of claims 1-5, 7, 9-14, 16, 18-21, 52, and 53, the rejection should be withdrawn and the claims should be allowed.

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[1] *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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Independent claim 1 recites "[a] method for *externally* identifying a particular caller, said method comprising: receiving a voice utterance for a caller *at a server external to a trusted telephone network* . . . ." In rejecting claims 1-5 and 7 as anticipated by Bartholomew, the Office Action states that the 'IP 23' of Bartholomew "reads on the claim 'server' and 'central office' reads on claim 'trusted telephone network'"[2] Bartholomew teaches that both the IP and the central office are *included* in the preferred network and therefore, are not "a server *external* to a trusted telephone network." The IP of Bartholomew is an acronym for "intelligent peripheral" and Bartholomew states "[t]he preferred telephone network includes one or more intelligent peripherals (IPs) 23 . . . ."[3]   The central office of Bartholomew is a switch that is also within a telephone network.[4] The IP and a central office—both included within the network of Bartholomew—therefore do not anticipate, "[a] method for *externally* identifying a particular caller . . . comprising: receiving a voice utterance for a caller at a server *external* to a trusted telephone network . . . ." Rejected claims 2-5, and 7 depend from claim 1 and therefore include all of the limitations of claim 1. Because Bartholomew does not teach each and every element as set forth in claims 1-5, and 7 the rejection should be withdrawn and the claims should be allowed.

Independent claim 10 recites "[a] system for *externally* identifying a particular caller, said system comprising . . . "a server system communicatively connected to a trusted telephone network by an *external network* . . . and means for transmitting said caller identity to said *trusted telephone network* as an authenticated identity of said caller for a call." In rejecting claims 10-14 and 16 as anticipated by Bartholomew, the Office Action states "IP23(remote)' reads on the claim 'server system, 'central office' reads on the claim 'trusted telephone network', and 'TCP/IP network' reads on the claim 'external network'" citing columns 17, lines 62-67 and columns 18, lines 1-25."[5] The cited columns do not teach a "trusted telephone network" or any "a server system communicatively connected to a trusted telephone network by an *external network*" as

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[2] Office Action Dated April 23, 2003, paragraph 7, page3 - page 4.
[3] U.S. Patent No. 6,167,119, column 11, line 63 – 66.
[4] U.S. Patent No. 6, 167, 119, column 9, lines 20 – 31.
[5] Office Action Dated April 23, 2003, paragraph 7, page 5.

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recited in claim 10. By contrast, the cited columns of Bartholomew describe an IP[6] and TCP/IP network which are *included* in the preferred network of Bartholomew[7] and therefore do not anticipate a "system for *externally* identifying a particular caller." Claims 11-14 and 16 depend from independent claim 10 and therefore include all the limitations of claim 10. Because Bartholomew does not teach each and every element as set forth in claims 10-14, and 16, the rejection should be withdrawn and the claims allowed.

Independent claim 18 recites "[a] computer program product for *externally* identifying a particular caller, the computer program product comprising . . . "means, recorded on said recording medium, for controlling transmission of said caller identity *to said trusted telephone network* as an authenticated identity of said caller for a call." In rejecting claims 18-21 as anticipated by Bartholomew, the Office Action states "'IP (remote)' reads on the claim 'server system', 'central office' reads on the claim 'trusted telephone network' and 'TCP/IP network' reads on the claim 'external network'" citing Figure 1, column 13, lines 41-60, column 17, lines 62-67, and column 18, lines 1-25. The cited columns do not teach a "trusted telephone network" or "controlling transmission of said caller identity *to said trusted telephone network* as an authenticated identity of said caller for a call." By contrast, the cited columns of Bartholomew describe an IP[8] and TCP/IP network which are *included* in the preferred network of Bartholomew[9] and therefore do not anticipate a "computer program product for *externally* identifying a particular caller." Claims 19-21 depend from claim 18 and therefore include all of the limitations of claim 18. Because Bartholomew does not teach each and every element as set forth in claims 18-21, the rejection should be withdrawn and the claims allowed.

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[6] U.S. Patent No. 6, 167, 119, column 17, line 62 – column, 18, line 25; ("The illustrated IP also *includes* . . .").

[7] U.S. Patent No. 6,167,119, column 9, lines 12-13 ("FIG. 1 provides a simplified illustrated of the preferred intelligent telephone network for implementing the personal dial tone service in accord with the present invention.") U.S. Patent No. 6,167,119 column 11, line 63 – 66 ("The preferred telephone network *includes* one or more intelligent peripherals (IPs) 23. . . "); U.S. Patent No. 6,167,119, Figure 1.

[8] U.S. Patent No. 6, 167, 119, column 17, line 62 – column, 18, line 25; ("The illustrated IP also *includes* . . .").

[9] U.S. Patent No. 6,167,119, column 9, lines 12-13 ("FIG. 1 provides a simplified illustrated of the preferred intelligent telephone network for implementing the personal dial tone service in accord with the present invention.") U.S. Patent No. 6,167,119 column 11, line 63 – 66 ("The preferred telephone network *includes* one or more intelligent peripherals (IPs) 23 . . ."); U.S. Patent No. 6,167,119, Figure 1.

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Independent claim 52 recites "[a] method for controlling caller identification, comprising ... receiving, *from a trusted telephone network*, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible *via a network external* to said trusted telephone network, wherein said trusted telephone network initiates said authentication service ..." In rejecting claim 52 as anticipated by Bartholomew, the Office Action states "'central office' reads on the claim 'trusted telephone network' ... 'IP23' reads on the claim 'network'" citing Figure 1 and column 13, lines 41-60. The cited Figure and lines of Bartholomew do not teach "receiving, *from a trusted telephone network*, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated *at a authentication service accessible via a network external to said trusted telephone network* ..." By contrast, the cited columns of Bartholomew describe an IP[10] and TCP/IP network which are *included* in the preferred network of Bartholomew[11] and therefore do not anticipate claim 52 that recites "receiving, *from a trusted telephone network*, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible *via a network external to said trusted telephone network* ..." Because Bartholomew does not teach each and every element of claim 52, the rejection should be withdrawn and the claim 52 should be allowed.

Independent claim 53 recites "[a] method for controlling a call, comprising ... receiving, at a telephony device, *a secure communication channel via a trusted telephone network to an authentication service* ...." In rejecting claim 53 the Office Action states 'digital transport channel' reads on 'secure channel" citing Figure 1, and column 12, lines 6-15, column 13, lines 41-60, column 17, lines 62-67, and column 18-lines 1-25. The cited columns of Bartholomew teach a "digital transport for a number of two-way voice grade

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[10] U.S. Patent No. 6, 167, 119, column 17, line 62 – column, 18, line 25; ("The illustrated IP also *includes* . .. ").

[11] U.S. Patent No. 6,167,119, column 9, lines 12-13 ("FIG. 1 provides a simplified illustrated of the preferred intelligent telephone network for implementing the personal dial tone service in accord with the present invention.") U.S. Patent No. 6,167,119 column 11, line 63 – 66 ("The preferred telephone network *includes* one or more intelligent peripherals (IPs) 23 . . ."); U.S. Patent No. 6,167,119, Figure 1.

telephone communications and a channel transporting signaling data messages in both directions between the switch and the IP,"[12] not "receiving, at a telephony device, *a secure communication channel via a trusted telephone network to an authentication service . . . ."* Because Bartholomew fails to teach each and every element as set forth in claim 53, the rejection should be withdrawn and the claim should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 6, 8, 15, and 17 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of U.S. Patent Application, U.S. Pub. No. 2002/0136363 to Stumer or U.S. Pub. No. 2001/0047414 to Yoon. Applicants respectfully traverse each rejection. Not one of the proposed combinations can establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met.[13] First, the combination must teach or suggest all of Applicants' claim limitations.[14] Second, there must be a suggestion or motivation to combine the references.[15] Finally, there must be a reasonable expectation of success in the combination.[16]

Bartholomew and Stumer

Claims 6 and 15 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of Stumer. The combination of Bartholomew and Stumer cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 6 and 15, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

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[12] U.S. Patent No. 6, 167, 119, column 12, lines 12-16.
[13] Manual of Patent Examining Procedure §2142.
[14] *In re Royka,* 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).
[15] *In re Vaeck,* 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).
[16] *In re Merck & Co., Inc.,* 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

The combination of Bartholomew and Stumer does not teach or suggest all of Applicants' claim limitations. As discussed above, Bartholomew teaches an IP and a central office included in the preferred network, not a method or system "for *externally* identifying a particular caller" comprising "receiving a voice utterance for a caller *at a server external to a trusted telephone network* . . ." as included in claim 6 or "means for transmitting said caller identity to said *trusted telephone network* as an authenticated identity of said caller for a call" as included in claim 15. Stumer does not cure the deficiencies of Bartholomew, because Stumer also fails to teach "receiving a voice utterance for a caller *at a server external to a trusted telephone network* . . ." as included in claim 6 or "means for transmitting said caller identity to said *trusted telephone network* as an authenticated identity of said caller for a call" as included in claim 15. Stumer instead teaches accurate transmission of a callback number from an emergency caller after the emergency call goes on-hook,[17] which is not the method or system "for *externally* identifying a particular caller" of claims 6 and 15. Because the combination of Bartholomew and Stumer does not teach each and every element of claims 6 and 15 the rejection should be withdrawn and the claims should be allowed.

There is also no suggestion or motivation to combine Bartholomew and Stumer. There is no suggestion or motivation to combine Bartholomew and Stumer because both references lack the same teaching. That is, both references do not teach, for example, "receiving a voice utterance for a caller *at a server external to a trusted telephone network* . . . ." or "a server system communicatively connected to a trusted telephone network by an *external network* . . . and means for transmitting said caller identity *to said trusted telephone network* as an authenticated identity of said caller for a call." There is no suggestion or motivation to combine the references, because the resultant combination still does not teach the limitations of claims 6 and 15.

There is no reasonable expectation of success in the proposed combination. Because both Bartholomew and Stumer fail to teach "receiving a voice utterance for a caller *at a server external to a trusted telephone network* . . . ." or "a server system communicatively

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[17] U.S. Patent Application Publication No., U.S. 2002/0136363 A1, abstract.

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connected to a trusted telephone network by an *external network . . .* and means for transmitting said caller identity *to said trusted telephone network* as an authenticated identity of said caller for a call" the combination cannot work to receive "a voice utterance for a caller *at a server external to a trusted telephone network . . . .*" or teach "a server system communicatively connected to a trusted telephone network by an *external network . . .* and means for transmitting said caller identity *to said trusted telephone network* as an authenticated identity of said caller for a call." Said differently, Bartholomew and Stumer together cannot teach what is not disclosed in either reference alone. The combination therefore fails to establish a prima facie case of obviousness.

Bartholomew and Yoon

Claims 8 and 17 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of Yoon. The combination of Bartholomew and Yoon also cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 8 and 17, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The combination of Bartholomew and Yoon does not teach each and every element of claims 8 and 17. As discussed above, Bartholomew teaches an IP and a central office included in the preferred network, not the method or system "for *externally* identifying a particular caller" comprising "receiving a voice utterance for a caller *at a server external to a trusted telephone network . . . .*" as included in claim 8 or "a server system communicatively connected to a trusted telephone network by an *external network . . .* and means for transmitting said caller identity *to said trusted telephone network* as an authenticated identity of said caller for a call" as included in claim 17. Yoon does not cure the deficiencies of Bartholomew because Yoon also fails to teach "receiving a voice utterance for a caller *at a server external to a trusted telephone network . . .*" as included in claim 8 or "a server system communicatively connected to a trusted telephone network by an *external network . . .* and means for transmitting said caller identity *to said trusted*

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telephone network as an authenticated identity of said caller for a call" as included in claim 17. Yoon instead teaches a service method for construction of networks having automatic backup and load balancing upon failures to networks and systems,[18] which is not the method or system "for *externally* identifying a particular caller" of claims 8 and 17. Because the combination of Bartholomew and Yoon does not teach each and every element of claims 8 and 17, the combination cannot establish a prima facie case of obviousness and the rejection should be withdrawn.

There is no suggestion or motivation to combine Bartholomew and Yoon. The Office Action combines Bartholomew and Yoon through an "IP" stating "Yoon teaches accessing the IP from the PSTN network though a dedicated private network."[19] There is no suggestion or motivation to combine Bartholomew and Yoon because the IP of Bartholomew is an acronym for "intelligent peripheral"[20] and the IP of Yoon stands for "internet protocol."[21] That is, the two references include the abbreviation "IP," but they are completely different things. The IP of Bartholomew and the IP of Yoon share an abbreviation by coincidence. Because the IP of Bartholomew is completely different from the IP of Yoon, there is no suggestion or motivation to combine Bartholomew and Yoon as suggested in the Office Action. The combination cannot establish a prima facie case of obviousness and the rejection should be withdrawn.

There is no reasonable expectation of success in the combination of Bartholomew and Yoon. As discussed above, the IP of Bartholomew is an acronym for "intelligent peripheral."[22] The IP of Yoon is an abbreviation of "internet protocol."[23] An intelligent peripheral is not the same as and IP address and cannot work as an IP address. Because there is no reasonable expectation of success in the combination of Bartholomew and Yoon, the combination cannot establish a prima facie case of obviousness. The rejection of claims 8 and 17 should be withdrawn.

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[18] U.S. Patent Application Publication No. U.S. 2001/0047414 A1.
[19] Office Action Dated April 23, 2003, paragraph 10, page 9.
[20] U.S. Patent No. 6,167,119, column 11, line 63 – 66.
[21] U.S. Patent Application No. 2001/0047414, paragraph 73.
[22] U.S. Patent No. 6,167,119, column 11, line 63 – 66.
[23] U.S. Patent Application No. 2001/0047414, paragraph 73.

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Conclusion

Bartholomew, alone or in combination with Stumer or Yoon, does not teach each and every element of claims 1-21, 52, and 53. Bartholomew therefore does not anticipate claims 1-5, 7, 9-14, 16, 18-21, 52, and 53. The proposed combinations of Bartholomew and Stumer or Yoon fail to establish a prima face case of obviousness because the proposed combinations do not teach each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combination. Applicants respectfully request the allowance of claims 1-21, 52, and 53.
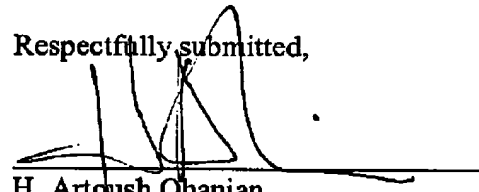
The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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